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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,947	03/08/2000	Norman Paul Forno	FPM1114707	1127

26389 7590 07/02/2003

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EXAMINER

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ART UNIT	PAPER NUMBER
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1761

16

DATE MAILED: 07/02/2003

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 16

Application Number: 09/520,947
Filing Date: March 08, 2000
Appellant(s): FORMO, NORMAN PAUL

MAILED

Thomas M. Donahue, Jr.
For Appellant

JUL 2 2003

GROUP 1700

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 19, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 25-31 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 32-35 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

US 3,428,240 A	Morris	2-1969
NZ 243,745 A	McEachen	8-1996
GB 2,331,059 A	Theed	12-1999
US 5,741,075 A	Collins et al.	4-1998
US 2,132,144 A	Blum	10-1938

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 25, 26, 30-34 are rejected under 35 U.S.C. 103 (a) over Morris (US 3428240) in view of McEachen (NZ 243745) and Theed (GB 2331059).

Claims 27 is rejected under 35 U.S.C. 103 (a) over Morris (US 3428240) in view of McEachen (NZ 243745) and Theed (GB 2331059), further in view of Collins (US 5741075).

Claims 28 and 35 are rejected under 35 U.S.C. 103 (a) over Morris (US 3428240) in view of McEachen (NZ 243745) and Theed (GB 2331059), further in view of Blum (US 2132144).

Claim 29 is rejected under 35 U.S.C. 103 (a) over Morris (US 3428240) in view of McEachen (NZ 243745) and Theed (GB 2331059), further in view of Collins (US 5741075), further in view of Blum (US 2132144).

These rejections are set forth in prior Office Action, Paper No. 8.

(11) Response to Argument

Claims 25, 26, 30, and 31

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the primary reference, Morris, teaches placing a loaf of bread in an inner package that has one end with a weakening opening means (i.e. perforations) for enabling access to the loaf by a consumer, inserting the inner package into an outer bag such that the end of the inner package with the weakening opening means is inserted last, and closing the outer bag. Morris differs from the method of claim 25 in two steps :

- Feeding the bread into a *bag* having a closed end with a weakening opening means.
- Heat shrinking the inner bag.

The secondary reference, McEachen, like Morris, teaches a *sealed* bread *package* having an end with a weakening opening means. McEachen further teaches feeding the bread into a bag having a closed end with a weakening opening means,

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and the open end is heat-sealed. Thus, McEachen teaches a bag that has an equivalent function as the wrapper of Morris: a sealed bread package with a weakening opening means located at one end, and provides motivation to substitute a bag filling step for the wrapper filling step of Morris.

The tertiary reference, Theed, teaches feeding bread into a bag having a closed end, heat-shrinking the bag (to preserve the bread), and inserting the bag into an outer bag. Theed heat-shrinking the inner bag around the bread kills any bacteria on the bread surface. Thus, Theed not only provides further motivation for substituting a bag for the wrapper of Morris, but Theed also provides motivation for heat shrinking since this will kill bacteria on the bread surface.

Appellant argues that the bag of McEachen cannot be used as a substitute for the inner wrapper of Morris because McEachen suggests the bag is an outer bag. Appellant also argues that even if McEachen could be used as an inner bag, McEachen teaches construction to allow access to the bread at either ends, whereas Morris teach the inner package allows access at one end. Neither of these arguments is persuasive. First, the disclosure of McEachen does not limit the use of the bag to either an outer or inner bag. Second, McEachen may teach allowing access at either end of the bag, but it is noted that both McEachen and Morris both teach one end of the inner package comprises a weakening opening means and one end is heat sealed (Note Page 2, lines 7-11,17-21 and Page 3, lines 8-12 of the Specification of McEachen and Column 3, lines 5-8 of Morris). Clearly the heat sealed structure of Morris would also allow access at either end, but Morris prefers access through the

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perforated end over the heat sealed end (Column 3, lines 5-8). Thus, the McEachen does teach a bag that has an equivalent function as the inner package of Morris: a sealed bread package with a weakening opening means located at one end.

Appellant also argues that bag of McEachen cannot provide the function of the inner package of Morris, which is to firmly maintain bread slices in a position, and Theed cannot provide motivation of heat shrinking an inner bag because Theed teaches an inner bag that must be completely removed to access the bread. In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). First, it is irrelevant how Theed accesses the bread once it is heat-sealed, since the method of accessing the bread (i.e. via a weakening opening means) is taught by the primary reference Morris. Second, Theed teaches inserting bread into an inner bag that is placed within an outer bag, which supports the substitution of the bag of McEachen for the wrapper of Morris. Theed also teaches heat shrinking an inner bread bag will better preserve the bread, providing motivation for not only using a bag, but heat shrinking the bag of McEachen. Third, heat-shrinking a bag of bread would provide the added benefit, and function sought by Morris, of holding the bread in a firm position.

Appellant argues that none of the references teach the manner in which the bread is placed in the inner bag and the heat shrunk inner bag is placed within the second outer bag, as recited in the dependent claims 30 and 31. However, broadly

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providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art (*In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)). Morris teaches providing a mercantile bread package (Column 1, lines 50-65). It is notoriously well known in the art to automatically perform bread-packaging steps for mercantile packages since the automation of packaging steps improves production rates and production efficiencies, while maintaining reduced labor costs. Thus, the skilled artisan would recognize the cost savings and improved efficiencies of automating the production of a bread package comprising inserting a heat-shrunk bread bag into an outer bag and would include the conventional steps of automatically feeding the bread into the inner bag by a first automatic bagging machine, transferring the filled inner bag from a first automatic bagging machine to a second automatic bagging machine, and automatically inserting the inner bag into an outer bag by a second automatic bagging machine.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Taken as a whole, McEachen and Theed, teach a method packaging a bread in an inner package that is bacteria free without deviating from the original intent of Morris:

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packaging a bread within an inner package having a weakening opening means that will maintain the bread slices in a firm position. Thus, Examiner's conclusion of obviousness is based on the prior art of record providing motivation to modify the primary reference Morris (i.e. substituting a step of filling a wrapper with the steps of filling a bag with bread and heat shrinking the bag will provide a bacteria free inner wrapper) and not on hindsight reasoning.

Claims 32 and 34

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Morris, teaches a loaf of bread in an inner package that has one end with a weakening opening means (i.e. perforations) for enabling access to the loaf by a consumer, and the inner package is inside an outer package with the weakening opening means closed to the reclosable opened end of the outer bag. Morris differs from package of claim 32 in that the inner package is a *wrapper*, and not a heat shrunk bag.

The secondary reference, McEachen, like Morris, teaches a *sealed* bread package having an end with a weakening opening means, but McEachen teaches a bag. Thus, McEachen teaches a bag that has an equivalent function as the wrapper of Morris: a sealed bread package with a weakening opening means located at one end, and provides motivation to substitute the bag for the wrapper of Morris.

The tertiary reference, Theed, teaches a heat shrunk inner bread bag packed inside an outer bag. The bag is heat shrunk to kill bacteria on the bread surface. Thus, Theed not only provides evidence of the conventionality of using a bag as an inner bread package inside an outer bag, but also provides motivation of using a heat shrunk inner bread bag because it will reduce bacteria on the surface of the bread.

Appellant argues that McEachen teaches the use of a single bag and thus suggests an outer package, which would not be equivalent to the inner package, or wrapper, of Morris. However, both references teach packages with one end having a weakening opening means and the other having a heat sealed end (Note Page 2, lines 7-11, 17-21 and Page 3, lines 8-12 of the Specification of McEachen and Column 3, lines 5-8 of Morris). Thus, Morris and McEachen teach bread packages with equivalent features for the same purpose: accessing bread in a package via a weakening opening means instead of breaking a heat seal.

Appellant also argues that Theed cannot provide motivation for a heat shrunk inner bag because Theed teaches an inner bag that must be completely removed to access the bread. First, it is irrelevant how Theed accesses the bread once it is heat-sealed, since a weakening opening means is already taught by the primary reference

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Morris and Theed is relied on to modify Morris. Second, Theed teaches bread packaged in an inner bag that is placed within an outer bag, which supports the substitution of the bag of McEachen for the wrapper of Morris. Third, Theed teaches heat shrinking an inner bread bag will kill bacteria on the surface of the bread, which would provide motivation for using a heat-shrunk inner bag.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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Examiner
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June 13, 2003

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